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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

D3239-00002

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on January 13, 2006

Signature

Typed or printed name Darlene DiPatri

Application Number

09/215,804

Filed

December 18, 1998

First Named Inventor

Mark Gavin et al.

Art Unit

2176

Examiner

William L. Bashore

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☐

attorney or agent of record.
Registration number _____

☒

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34

47,006

Signature

Joseph A. Powers

Typed or printed name

215-979-1842

Telephone number

January 13, 2006

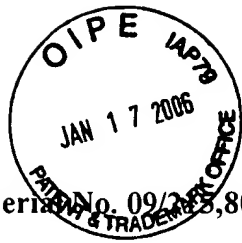
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below".

☐*Total of 2 forms are submitted.

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REASONS ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW

Claims 1-6, 8-14, 16-22, 24 and 26-34 are presently pending as set forth in the November 15, 2005 Response (the "After Final Response") to the September 16, 2005 Final Office Action. The Advisory Action states that the amendment to Claim 26 has been entered for purpose of this appeal.

All claims stand rejected as being obvious. Although the Advisory Action only addresses Claim 1, 2, 5, 6, 8-10, 13, 14, 16-18, 20-22, 24 and 29-33, Examiner Bashore informed attorney Joseph Powers in a telephone conversation on January 5, 2006 that he also intended to reject Claims 3, 4, 11, 12, 19, 26 and 27 and that a paper clarifying this point would be mailed.

In various responses, including the After Final Response, Applicants argued that three groups of claims rejected by the Examiner were allowable for the reasons summarized below.

A. Claims 1-2, 5-6, 8-10, 13-14, 16-18, 20-22, 24 and 28-33

Independent Claims 1, 9, 17 and 26 were amended to recite that the identified or designated content for redaction include at least one image. (See July 5, 2005 Response to April 5, 2005 Office Action). Claims 1, 9, 17 and 26 also recite that the one or more content objects comprise "one or more image occurrence objects." Applicants' invention can be employed in the redaction of text from, for example, PDF documents **and** in the redaction of images (i.e., pictures) from these documents. (Specification, Pages 6-7) as described in the After Final Response.

The Examiner has already conceded that the primary reference (Anderson) does not teach at least the step of "creating an electronic output file, said identified content not present in said output file, a redacted document being producible from said output file for display." Applicants have discussed Anderson in depth in prior responses. See, e.g., June 18, 2004 Response to December 18, 2003 Office Action. The Examiner has made this concession because Anderson clearly teaches an abstraction overlay methodology that does not remove the original content

from the electronic version of the abstracted document. Rather, the technique of Anderson overlays areas when a “redacted” document is displayed.

The Examiner then relies on Rackman for providing the missing step, **however, as argued previously and summarized below, Rackman teaches no more than Anderson with respect to redaction processes.**

A detailed discussion of Rackman is provided in Applicant’s After Final Response. As discussed therein, Rackman teaches a document access control system for use in litigation document production where two versions of a document are produced in electronic form to the requesting party. Unredacted documents are produced, but encrypted to preclude the receiving party from reviewing them until an encryption key is provided. If a judge rules that the receiving party can review the document in its original form, the producing party can simply provide the encryption key to the requesting party. Redacted documents are provided to the producing party without encryption (unless they are encrypted for confidentiality reasons) so that they can be readily accessed. (See, e.g., Column 7, Lines 53-57; See FIG. 5, Step 54 for different encryption levels and when they are used).

The only disclosure of Rackman regarding how redaction is accomplished, when necessary, is as follows: “[I]f redaction is required, then in step 32 an image is created which is a redacted form of the original. The original image is retained along with the redaction. **Standard software can be used for this purpose.**” (Column 8, Line 66 – Column 8, Line 2). There is no more detail than this on how the actual redaction process works. **Rackman, therefore, provides no more than does Anderson with respect to redaction processes for electronic documents.**

The Examiner states in the Advisory Action that the “examiner interprets said second form [the (unencrypted) redacted form of Rackman] as permanently redacted. It is the examiner’s opinion that interpreting said second forms as reversible would defeat the purpose of providing the non-redacted encrypted form.” Applicants disagree. Presumably Anderson would

have preferred that the redaction be irreversible, but Anderson apparently did not know how to do this, even if desirable. Rackman merely provides that “standard software” techniques (e.g., Anderson) can be used and does not cure the deficiencies of Anderson.

It should also be pointed out that the Examiner provides some last minute description of “standard software” in the comments of the Advisory Action but fails to identify any specific reference or consider the 1998 filing date of the present application.

Accordingly, it is submitted that the combination would simply provide a document redacted in the form taught by Anderson and thus, like Anderson, would not “creat[e] an **electronic output file**, said identified content **not present in said output file**, a redacted document being producible from said output file for display” as claimed by Applicants.

B. Claims 31-33

Claims 31-33 each recite that the removal step comprises “replacing pixels corresponding to the identified content,” i.e., the content comprising at least one image. Applicants have clearly distinguished image content and objects, for example pictures, from textual content and objects, for example, text. The Examiner states in the Final Rejection that “Rackman teaches redaction involving images and does mention pixels.” (emphasis added) The Examiner then concludes that “since modifications in an electronic document generally involve modifications of its representative pixels, it would have been obvious to one of ordinary skill in the art at the time of the invention to implement redaction via pixel by pixel replacement and/or modification.”

Applicants presented arguments directed to the deficiency in this rejection in the After Final Response, but the Advisory Action does not address these arguments in any way.

As argued in the After Final Response, by Applicants’ count, Rackman *mentions* “pixel” in one location, Column 3, Lines 12-16, in a discussion of rearranging “pixels representing the unredacted image” to accomplish the desired document encryption, not in connection with redacting information from the document. Simply, Rackman manipulates pixels in an encryption method, not a redaction methodology as claimed.

Further, Applicants submit that the Examiner has not provided any support in any Action thus far for the statement that “modifications in an electronic document generally involve modifications of its representative pixels . . .” Applicants submit that the combination of Anderson and Rackman, as discussed above, accomplishes visual modification using overlays as taught by Anderson (because Rackman uses “standard software”), not a replacement of pixels corresponding to image content in the removed of content and creation of an electronic output file with the identified content not present as claimed.

In the last Response, Applicants also cited to Patent Office Rule 104(c) and requested affidavit regarding the alleged personal knowledge of the Examiner. No such affidavit has been provided to date.

Claims 31-33 are allowable, therefore, as argued.

C. Independent Claims 5, 13 and 21; Dependent Claims 6, 8, 14, 16, 22 and 24

The Action rejects independent Claim 5 as being obvious from Anderson in view of Rackman, which is directed to a method for designating portions of a document comprising content including at least one image for redaction. A geographic region of a document is designated for redaction. The designating step includes manipulating a frame displayed on the documents where content having a geographical location within the frame is visible to the user during the manipulation step. The manipulable frame is shown, for example, as window 45 in FIG. 2 of Applicants’ disclosure.

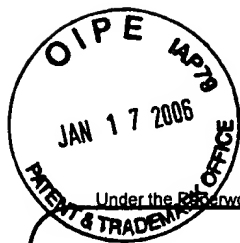
Applicants provided arguments directed to these claims in the After Final Response, but the Advisory Action does not address these arguments or the claims in any way. Applicants also provided arguments with respect to these claims in their July 5, 2005 and June 18, 2004 Responses. Applicants’ arguments are summarized hereafter.

The designating step is not a step of displaying the redacted documents, but rather a means of identifying areas for redaction. It appears from a reading of the rejection that the Examiner is focusing on the actual annotated document of Anderson, i.e., to the result of the

redaction, as opposed to the actual method Anderson uses to designate areas for annotation/redaction. Indeed, the Examiner cites to Figures 3A-3B and 4 of Anderson, which show the display of already annotated documents having annotation windows overlaid onto the document.

The portion of Anderson's disclosure upon which we must focus is how the system of Anderson enables the user to add the overlays, not the actual display. Anderson provides merely that the user can specify the characteristics and content of the annotation, including location, size and orientation, by a "command entry or a pull down menu." (Column 6, Lines 16-20). This is the only disclosure provided by Anderson regarding creation of its overlays. Rackman, discussed above, provides only that redaction can be done using "standard software" and does not cure the deficiency in Anderson as discussed in detail in the After Final Response.

In summary, the "command entry and pull down menu" do not teach or suggest that a frame is displayed to a user, with content visible in the frame, to assist in designating content to be redacted. It is submitted, therefore, that independent Claims 5, 13 and 21 and their dependent claims are allowable over the art of record.



PTO/SB/21 (09-04)

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Application Number

09/215,804

Filing Date

December 18, 1998

First Named Inventor

Mark Gavin et al.

Art Unit

2176

Examiner Name

William L. Bashore

Attorney Docket Number

D3239-00002

ENCLOSURES

(Check all that apply)



Fee Transmittal Form



Fee Attached



Amendment/Reply



After Final



Affidavits/declaration(s)



Extension of Time Request



Express Abandonment Request



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Reasons Accompanying Pre-Appeal Brief
Request for Review; return postcard**SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT**

Firm Name

Duane Morris LLP

Signature

Printed name

Joseph A. Powers

Date

January 13, 2006

Reg. No.

47,006

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January 13, 2006

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